

REMARKS

Applicants hereby add new claims 25-33. Accordingly, claims 1-33 are pending in the present application.

Claims 7-8, 10-11, 14, 16-19, 21-22, and 24 stand rejected under 35 USC 102(e) anticipation by U.S. Patent No. 6,735,641 B1 to Kobayashi et al. Claims 1-3, and 5-6 stand rejected under 35 USC 103(a) for obviousness over Kobayashi in view of U.S. Patent No. 6,758,316 B2 to Molbak. Claims 12-13 stand rejected under 35 USC 103(a) for obviousness over Kobayashi in view of Molbak. Claim 4 stands rejected under 35 USC 103(a) for obviousness over Kobayashi in view of Molbak and further in view of U.S. Patent No. 6,522,421 B2 to Chapman et al. Claims 9, 15, 20, and 23 stand rejected under 35 USC 103(a) for obviousness over Kobayashi in combination with Chapman.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to claim 1, to establish a proper prima facie rejection of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

Referring to page 7 of the Office Action, it is stated that processing circuitry 73, 75 of Kobayashi is configured to synchronize with another image forming device. The Office relies upon the teachings of Fig. 5 in support of the assertion that the printers 3-1 to 3-n are in synchronization. However, Fig. 5 merely shows the plurality of printers 3-1 to 3-n coupled with a network 2 of the management system 1. Fig. 5 is void of any disclosure or suggestion of synchronization between the plural printers let alone the explicitly claimed *processing circuitry of the image forming device configured to synchronize with another image forming device to control a timing of a communication of the message*. The associated specification teachings of Kobayashi also fail to disclose or suggest the claimed synchronization. In fact, Applicants have electronically searched Kobayashi and have failed to uncover any synchronization teachings. The mere disclosure of a plurality of

printers of Kobayashi fails to teach or suggest the claimed synchronization and claim 1 is allowable for at least this reason. Col. 6, lines 7-11 of Kobayashi merely discloses that control unit 31b of system 1 provides commands to obtain the internal information at intervals set in the time setting unit. However, there is absolutely no teaching or suggestion of the commands synchronizing any of the printers or synchronization of processing circuitry of one device with another device to control a timing of a communication of the message as positively claimed. Accordingly, even if the references are combined in a 103 rejection, the combination fails to disclose or suggest limitations of claim 1. Applicants respectfully request allowance of claim 1 in the next Action for at least this reason.

In addition, there is no proper motivation to combine the reference teachings and the 103 rejection is improper for at least this additional reason. For example, the Office states on page 8 of the Action that the combination is appropriate to "increase the functionalities of the processing circuitry for automatically reporting the statuses" and to "avoid the requesting report by the output device so that the burden of the traffic on the network is eliminated." The alleged motivational rationale is deficient to support a proper 103 rejection.

More specifically, the rationale is only based upon the subjective opinions of the Examiner which are not supported by the prior art teachings or other evidence of record and accordingly is deficient. The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated

that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth objective rationale on which it relied.

There is absolutely no evidence to support the allegations of motivation set forth in the Office Action. There is no evidence that Kobayashi is deficient with respect to communications between the printers 3. To the contrary, system 1 of the Kobayashi clearly discloses a time setting unit 31c for providing appropriate times for communications. Kobayashi provides a *centralized control system* for controlling the timing of communications (i.e., when the system 1 of Kobayashi needs the information or is ready to accept the information). There is no evidence that the disclosure of Kobayashi is deficient or that one would be motivated to look to another reference for meaningful teachings. There is no evidence that the functionalities of the processing circuitry would be increased by the proposed modification and accordingly no sufficient motivation to combine the references is provided. There is no evidence to support the position of the Office that there exist bandwidth concerns or that elimination of the minimal commands of Kobayashi would "eliminate" a burden of the traffic upon a network. Further, any network burden would not be alleviated by eliminating the communication of brief commands by system 1. Even if bandwidth limitations were a problem and that removal of the commands would eliminate a burden (which is not supported by any evidence), there would be significant alterations of the system of Kobayashi with no or minimal improvement which is insufficient to alter Kobayashi against its clearly provided centralized system for issuing commands for controlling the communication of messages from the printers 3. Kobayashi provides a centralized system which makes the maintenance and *management* of printers easier per col. 1, lines 27-29 and there is no motivation to relinquish the management as would result from the modification of Kobayashi as proposed by the Office. The Office has not

met its burden of establishing the requisite motivation to combine the reference teachings and the Office has failed to establish a prima facie rejection for this additional reason. Claim 1 is allowable for at least the above-mentioned numerous reasons.

Despite the assertions of the Office, positively recited limitations of claim 1 are not taught nor suggested by the prior art as noted above. In the event that a rejection of claim 1 is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 1 is not found to be allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 4, on page 11 of the Action, it is recognized that the combined teachings of Kobayashi and Molbak fail to disclose or suggest the formulation of the message comprising an e-mail message. It is stated on page 11 that it is appropriate to combine the teachings of Chapman in support of the rejection to increase the functionality of the printers and to be flexible for communicating with other apparatuses by email communication. Applicants respectfully assert that proper motivation is lacking and the Office has failed to establish a proper 103 rejection. The mere fact that references can be combined is insufficient unless there is motivation to combine the reference teachings. MPEP §2143.01 *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Kobayashi already provides a system for communicating using the network. There is no evidence that the communications are deficient or that one would look for an alternative means for communication. There is no evidence that communications of the system of Kobayashi would be improved by the proposed modification. The bald unsupported allegations of the Office are insufficient to support the combination of the reference teachings. The only motivation results from improper reliance upon Applicants' disclosure and claim 4 is allowable for at least this additional reason. In particular, the motivation for forming the combination must be something other than hindsight reconstruction based on using Applicants' invention as a road map for such a combination. *See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

Referring to claim 7, the claimed device comprises processing circuitry configured to generate a *message indicating a status of the imaging consumable* and to *communicate the message externally of the device at a moment in time determined internally of the image forming device*. Claim 7 recites patentable subject matter.

Kobayashi discloses that a printer operation management system 1 communicates with plural printers 3. Printer internal information acquiring unit 31 internal of system 1 (and external of printers 3) is configured to *give commands to printers 3 to obtain internal information of printers 3 at intervals set in time setting unit 31c of system 1* as set forth in col. 6, lines 7-12. The specification of the time to access the internal information of the printers using the time setting unit 31 external of printers 3 fails to disclose or suggest the claimed *processing circuitry of the image forming device* configured to *communicate the message externally of the imaging forming device at a moment in time determined internally of the image forming device* as defined in claim 7. Claim 7 is allowable for at least this reason.

The claims which depend from independent claim 7 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 11, the processing circuitry is configured to forward the composite message to an interface *for communication at substantially the same*

moment in time that another image forming device communicates another message which includes a status of an imaging consumable of the another image forming device. Kobayashi discloses that the management system 1 sends commands to retrieve information from printers at intervals set by the time setting unit 31c. Kobayashi is void of any teaching or suggestion that messages are communicated from printers 3 to system 1 at substantially the same moment in time. Positively-recited limitations of claim 11 are not disclosed nor suggested by the prior art and claim 11 is allowable for at least this reason.

The claims which depend from independent claim 11 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 17, Kobayashi is void of any teaching or suggestion of synchronizing with another image forming device and communicating the message indicating the status of the consumable externally of the image forming device responsive to the synchronizing. The mere disclosure of plural printers 3 of Kobayashi fails to disclose or suggest any synchronization or communications responsive to synchronization. Applicants have electronically searched Kobayashi and have failed to uncover any synchronization teachings. Positively recited limitations of claim 17 are not taught nor suggested by the prior art and claim 17 is allowable for at least this reason.

The claims which depend from independent claim 17 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 22, the prior art of record fails to disclose or generating a message indicating the status of an imaging consumable and communicating the message at a moment in time determined internally of the image forming device. The prior art discloses communicating commands using a management system external of the printers to retrieve information from the printers. The printers do not communicate at moments in time determined internally of the device but only responsive to received commands. The usage of the management system to control the communications fails to disclose or suggest the claimed communicating

as recited in claim 22. Claim 22 recites limitations not disclosed nor suggested by the prior art and claim 22 is allowable for at least this reason.

The claims which depend from independent claim 22 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Support for the new claims and claim amendments is provided at least at pages 8-12 and Figs. 3-4 of the originally filed application.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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